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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,222	12/20/1999	DAVID ALLEN	002880.P001C	3372

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EXAMINER

LE, UYEN T

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/468,222

Applicant(s)

ALLEN ET AL.

Examiner

Uyen T. Le

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 21-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 21-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>30 Aug 04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment is insufficient to remedy the lack of antecedent basis in claim 28, "the selected information object", claim 30 "the selected action", claim 31 "the desired action", claim 45 "the detected information object".

2. Applicant has not provided a copy of all claims with clear markings of what has been added or deleted. An example is claim 26 indicated in parenthesis as currently amended but shows no text underlined. Another example is former claim 45 shown as currently amended differs from amended claim 45 by more than one word, but only one word is underlined in the amended claim.

3. Applicant's arguments filed 30 August 2004 have been fully considered but they are moot in view of the new grounds of rejection presented in this Office Action.

Applicant seems to argue the claims as amended.

Applicant argues that in Ohmaye, the user does not receive any feedback about his or her statement before it is submitted to the simulation. In response, amended claim 1 merely requires "a user output device to provide, prior to the message being sent, an indication of an action to be taken by the associated information object in response to the message from the user". This limitation is not supported by the specification. Where is the message being sent? And what is an indication of an action to be taken by the information object in response to the message from the user?

Applicant further argues that in Ohmaye, the user's statement is only parsed once it is dispatched and that Ohmaye does not teach or suggest parsing the statement prior to its dispatch. In response, it is not clear to where the user input message is being sent and how the user output device operates prior to the message being sent.

Applicant argues that in claim 52 newly added, any message entered can be processed even if no keyword is present, either by the system assigning by default a particular information object to do the processing, or by the operator selecting one manually. In response, there is no support in the specification regarding these newly added limitations.

Applicant argues that in amended claim 24, text other than the keyword is treated as variable data for processing by the selected information object. In response, again this limitation is not supported by the specification.

Regarding amended claims 36, 49, applicant argues the limitation of "prior to executing the information object". In response, this limitation is not discussed in the specification.

Applicant's arguments regarding new claims 53-55 have been fully considered but they are moot in view of the new grounds of rejection presented in this Office Action.

Regarding claims 56, 57, applicant argues that Ohmaye does not teach or suggest a keyword including an alias created by the user to customize the user interaction with the system. In response, this limitation is not supported by the specification. Furthermore, it is not clear what applicant meant by "the execution of the information object" at line 4 of claim 57.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 21-52, 56, 57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed "a user output device to provide, prior to the message being sent, an indication of an action to be taken by the associated information object in response to the message from the user", "any message entered can be processed even if no keyword is present, either by the system assigning by default a particular information object to do the processing, or by the operator selecting one manually", "text other than the keyword is treated as variable data for processing by the selected information object", "prior to executing the information object", "adding an alias to keywords associated with an information object" are not discussed in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 21-52, 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1, it is not understood what applicant meant by the last paragraph "a user input device to provide, prior to the message being sent, an indication of an action to be taken by the associated information object in response to the message from the user".

Claims 36, 49, 57, it is not understood what applicant meant by "executing an information object".

Claim 28, last line "the selected information object", claim 30, last line "the selected action", claim 31, last line "the desired action", claim 45, line 2 "the detected information object", claim 57, line 4 "the execution of the information object" lack antecedent basis.

Art rejection is not being applied to claims 1, 21-52, 57 because the limitations cannot be ascertained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 53-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Coad et al (US 5,966,652).

Regarding claim 53, Coad discloses an apparatus for executing action in response to a message entered by a user in a computer system (see the abstract,

Figures 2-4). Note user input device 20 for receiving an input message from the user, a parser 124 to identify a keyword in the input message, the parser to parse the input message as it is entered to immediately detect a keyword as it is entered (text parser detects start delimiter and termination delimiter), and the parser further to associated the input message to an information object (call-back telephone number) associated with the keyword (text data portion corresponding to the call back telephone number), a user output device 16 to provide information to the user (Figure 4).

Regarding claim 54, Coad discloses wherein the parser parses the input message upon detection of a word delimiter (see the abstract).

Regarding claim 55, Coad discloses wherein the parser parses the input message character-by-character as it is entered by the user (see the abstract).

Regarding claim 56, Coad discloses the user input device 102 to enable a user to customize keywords, by adding an alias (delimiters) to keywords (test data portion) associated with an information object (call-back telephone number), the alias used to invoke the information object (call-back telephone number).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 571-272-4021. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9 December 2004



UYEN LE
PRIMARY EXAMINER